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CHEN, JOSE V

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WILLIAM P. APPS, JEFF WILKERSON, and  
BRIAN MUSSER

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Appeal 2010-004170  
Application 09/439,427  
Technology Center 3600

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Before STEFAN STAICOVICI, MICHAEL C. ASTORINO, and  
BRADFORD E. KILE, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

William P. Apps et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision finally rejecting under 35 U.S.C. § 102(b) claim 36 as anticipated by Wyler (US 5,868,080, issued Feb. 9, 1999) and under 35 U.S.C. § 103(a) claims 22, 23, 26, 29-31, 34-37, and 39-55 as unpatentable over Pigott (US 5,197,395, issued Mar. 30, 1993), Wyler, and Fingerson (US 4,522,009, issued Jun. 11, 1985) and claims 24, 25, 27, 28, 32, 33, and 38 as unpatentable over Pigott, Wyler, Fingerson, and Sturgis (US 2,599,076, issued Jun. 3, 1952).<sup>1</sup> Claims 1-21 have been canceled.

Appellants present additional evidence in the Declaration filed on Jan. 21, 2003 under 37 C.F.R. § 1.132 of William P. Apps (hereafter referred to as "Apps Declaration")<sup>2</sup>.

We have jurisdiction over this appeal under 35 U.S.C. § 6.

## THE INVENTION

Appellants' invention relates to a synthetic resin pallet including providing a "slip-resistant scuffed texture" on the top surface of the upper deck, the bottom surface of the lower deck, and the underside of the upper deck. Spec. 4, ll. 24-27.

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<sup>1</sup> This is Appellants' second appeal before the Board of Patent Appeals and Interferences. In the first appeal (2002-1675, Decision mailed November 21, 2002) (hereafter "Decision"), the rejections under 35 U.S.C. § 103(a) of claims 22, 23, 26, 29-31, and 34-37 as unpatentable over Pigott, Wyler, and Fingerson and of claims 24, 25, 27, 28, 32, 33, and 38 as unpatentable over Pigott, Wyler, Fingerson, and Sturgis were affirmed, and pursuant to 37 C.F.R. § 41.50(b), were denominated as new grounds of rejection. Decision, 12-13.

<sup>2</sup> The Declarant, Mr. William P. Apps, is also a co-inventor in the instant application.

Claim 22, with emphasis added, is illustrative of the claimed invention and reads as follows:

22. A synthetic resin pallet, for use with a fork lift, having upper and lower decks spaced apart by a plurality of supports to define therebetween fork-receiving regions beneath the upper deck, the pallet made by a method comprising:

(a) separately molding the upper and lower decks of synthetic resin;

(b) *mechanically scuffing* a top surface of the upper deck, a bottom surface of the lower deck, and an underside of the upper deck in the fork-receiving regions to create scuffs forming a slip-resistant scuffed texture thereon; and

(c) assembling tile decks to form a finished pallet.

## SUMMARY OF DECISION

We AFFIRM.

## ANALYSIS

### *The anticipation rejection*

Independent claim 36 is drawn to a pallet including at least one deck member prepared by “mechanically scuffing” at least one of a first and second surfaces of the deck member to form a “slip resistant surface thereon.” App. Br., Claims Appendix.

The Examiner found that Wyler teaches a pallet having an anti-skid surface formed by knurling or roughening. Ans. 3-4. *See also*, Wyler, col. 4, ll. 16-18. The Examiner further found that because (1) “scuff” is defined as “to be or become marred or scratched” and (2) the surface of Wyler’s pallet is knurled or roughened, Wyler’s surface “provides a marred, scratched and scuffed surface.” Ans. 4.

In response, pointing to the Apps Declaration, Appellants argue that because “the claimed ‘scuffed’ surface is distinguishable from the Wyler surface . . . the product produced by the claimed [process] is different from the Wyler product.” App. Br. 6. According to Appellants, while the Wyler surface would have a bumpy, shiny surface, the claimed scuffed surface would have a smooth, yet dull surface with visible scuff marks. *Id.*

In other words, Appellants urge that the limitation “mechanical scuffing” is a structural limitation, which must be considered for patentability. To the extent that Appellants’ position is that the structural characteristics inherently imparted to a product by mechanical scuffing are limitations of claim 36, we agree with Appellants.

The patentability of a product does not depend on its method of production. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985). Once the PTO has made out a prima facie case that the applicant's claimed product and the product of the prior art reasonably are the same, the burden shifts to the applicant to prove otherwise. *Id.* The burden of proof on the PTO in making out a case of prima facie obviousness for product-by-process claims is less than when a product is claimed in the more conventional fashion. *In re Fessman*, 489 F.2d 742, 744 (CCPA 1974).

In this case, Wyler teaches a pallet having an anti-skid surface formed by knurling or roughening. Wyler, col. 4, ll. 16-18. *See also*, Ans. 3-4. At the outset, we note that Appellants do not define the term “scuffing” in the Specification. *See* Spec. 8, l. 29 through Spec. 9, l. 2. Like the Examiner, we

find that an ordinary and customary meaning of the term “scuff” is “to become scratched, chipped or roughened by wear.” MERRIAM WEBSTER’S COLLEGIATE DICTIONARY (10<sup>th</sup> Ed. 1997). Thus, we find that a mechanically scuffed surface is a surface that is “scratched, chipped or roughened.”

Appellants further explain that “[t]he mechanical scuffing process that we claim is a surface operation which removes the shine and slipperiness from the outermost surface of the polymer deck surface.” Apps Declaration, para. 2. However, Appellants have not shown that Wyler’s knurled or roughened surface has any structural attributes that would not be achievable by mechanical scuffing. We are not persuaded that knurling or roughening of Wyler’s pallet would not remove the shine and slipperiness from the outer surface of Wyler’s deck. Moreover, we find Appellants’ position that the “knurling” or “roughening” process in Wyler necessarily includes molding of protrusions or ridges to be speculation based on Appellants’ opinion. *See* Apps Declaration, paras.7) and 8) and Reply Br. 1. Attorney argument cannot take the place of evidence in the record. *Estee Lauder, Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997). Appellants have not provided any evidence that the “knurling” or “roughening” process in Wyler does not occur after the pultrusion process has been completed. *See* Wyler, col. 4, ll. 21-22.

Furthermore, although we appreciate Appellants’ position that it is undesirable to subject a fiberglass composite structure to “removing material or ‘mechanical scuffing’ the surface” (*see* Apps Declaration, para. 6, and Reply Br. 1-2), we note that Wyler’s reinforcing bars 32 are fabricated by pultrusion. In pultrusion, straight (unidirectional, long) fibers are longitudinally pulled through a resin bath to be encapsulated in the resin

material to form a “continuous solid part,” *i.e.*, reinforcing bars 32 of Wyler. Wyler, col. 4, ll. 36-39 and fig. 2. Thus, since the straight (unidirectional, long) fibers are unidirectionally aligned and embedded in resin, we do not agree that knurling or roughening of the surface would necessarily expose or damage the fiberglass fibers, as Appellants suggest.

In sum, Appellants have not provided any evidence that establishes that mechanical scuffing, *per se*, yields a structure that differs from that of Wyler’s knurled or roughened surface. For the above reasons, we find that (1) the evidence of record is sufficient to establish a *prima facie* case that Wyler’s knurled or roughened anti-skid surface and a mechanically scuffed slip-resistance surface reasonably appear to be the same, so as to shift the burden to Appellants to prove otherwise, and (2) Appellants have not come forth with any evidence or cogent reasoning to show that Wyler’s knurled or roughened anti-skid surface is not the same as a mechanically scuffed anti-slip surface. Therefore, we shall sustain the rejection of claim 36 under 35 U.S.C. § 102(b) as anticipated by Wyler.

*The obviousness rejection based upon Pigott, Wyler, and Fingerson  
Claims 22, 23, 26, 29-31, and 34-37*

The Examiner found that: (1) Pigott discloses a molded plastic pallet (Pigott, Abstract); (2) Wyler discloses the benefits of having a slip-resistant/anti-skid surfaces on a pallet (Wyler, col. 1, ll. 64-67); and (3) Fingerson discloses roughening a surface to form an anti-skid surface (Fingerson, col. 6, ll. 5-8). Ans. 5-6.

Appellants argue that: (1) the phrase “roughened or coated with another material” in column 6, lines 6-7 of Fingerson means that “another

material was added to roughen or coat the surface” and (2) like in Wyler, the term “roughened” does not mean “scuffed.” App. Br. 7.

With respect to Appellants’ first point, we believe Appellants’ position is based upon an unreasonably narrow reading or interpretation of the Fingerson disclosure. Fingerson specifically discloses that:

The upper surface of the upper flange portion 24 may be planar or as illustrated in FIG. 3, may be *roughened or coated with another material* so as to provide an increased gripping surface for the floor grating.

Fingerson, col. 6, ll. 5-8. Emphasis added.

We do not agree that the phrase “with another material” modifies both terms “roughened” and “coated,” as Appellants suggest. The use of the disjunctive term “or” and the lack of any comma after the term “coated,” implies that the phrase “with another material” modifies only the term “coated.” As such, we interpret the phrase “roughened or coated with another material” to mean that the upper surface of the upper flange 24 of Fingerson may either be (1) roughened or (2) coated with another material.

Regarding Appellants’ second point, for the reasons set forth *supra* with respect to Wyler, we find that the roughened anti-skid surface of Pigott, Wyler, and Fingerson is the same as a mechanically scuffed slip-resistance surface. Also for the reasons set forth above, we do not agree with Appellants’ position that “the ‘roughened’ surface of the fiberglass beam in Fingerson is molded with the beam.” See App. Br. 7. Appellants have not provided any evidence that Fingerson’s “roughening” cannot occur after a molding process.



In conclusion, for the foregoing reasons, and because Appellants do not argue the Examiner's proposed combination of the teachings of Pigott, Wyler, and Fingerson, we shall sustain the rejection under 35 U.S.C. § 103(a) of independent claims 22, 26, 31, and 36 as unpatentable over Pigott, Wyler, and Fingerson .

Lastly, because Appellants do not make any other substantive arguments with respect to the rejection of dependent claims 23, 29, 30, 34, 35, and 37, we shall also sustain the rejection of claims 23, 29, 30, 34, 35, and 37 over the combined teachings of Pigott, Wyler, and Fingerson . *See* App. Br. 7.

#### *Claims 39-55*

Appellants present separate arguments for the rejection of claims 39-44. App. Br. 7-8.

Specifically, with respect to claims 39 and 42-44, Appellants argue that the separate fiberglass beams of Wyler and the floor grating of Fingerson do not satisfy the limitations of claims 39 and 42-44. We are not persuaded by Appellants' argument because nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). In this case, the rejection of claims 39 and 42-44 is based upon the combined teachings of Pigott, Wyler, and Fingerson.

Regarding the rejection of claims 40 and 41, we note that statements which merely point out what a claim recites will not be considered a separate argument for patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). Specifically regarding claim 40, Appellants have not shown any error in the

Examiner's interpretation of the term "multi-directional." *See* Ans. 9. Similarly, with respect to claim 41, Appellants have not come forth with any evidence or cogent reasoning to show that the roughened anti-skid surface of Pigott, Wyler, and Fingerson is not the same as a wire brushed slip-resistance surface.

Lastly, we note that Appellants have not presented any other substantive arguments with respect to the rejection of claims 45-55 over the combined teachings of Pigott, Wyler, and Fingerson.

Accordingly, the rejection under 35 U.S.C. § 103(a) of independent claims 39 and 44 and their respective dependent claims 40-43 and 45-55, as unpatentable over Pigott, Wyler, and Fingerson, is likewise sustained.

*The obviousness rejection based upon Pigott, Wyler, Fingerson, and Sturgis*

Appellants argue that "Pigott, Wyler, and Fingerson do not teach scuffing or abrading a surface." App. Br. 9. We are not persuaded by Appellants' argument because for the reasons described *supra*. We find that the roughened anti-skid surface of Pigott, Wyler, and Fingerson is the same as a mechanically scuffed slip-resistance surface. Thus, we sustain the rejection of claims 24, 25, 27, 28, 32, 33, and 38 as unpatentable over Pigott, Wyler, Fingerson, and Sturgis.

## SUMMARY

The decision of the Examiner to reject claims 22-55 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2010-004170  
Application 09/439,427

AFFIRMED

JRG